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OBLON, SPIVAK, MCCLELLAND MAIER & NEUSTADT, P.C. 1940 DUKE STREET ALEXANDRIA, VA 22314				COPPOLA, JACOB C
ART UNIT		PAPER NUMBER		
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

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Office Action Summary	Application No.	Applicant(s)	
	10/518,797	TSUKAZAKI ET AL.	
	Examiner	Art Unit	
	JACOB C. COPPOLA	3621	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1) Responsive to communication(s) filed on 12 January 2009.

2a) This action is **FINAL**. 2b) This action is non-final.

3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4) Claim(s) 1-26 is/are pending in the application.

4a) Of the above claim(s) 14-26 is/are withdrawn from consideration.

5) Claim(s) _____ is/are allowed.

6) Claim(s) 1-13 is/are rejected.

7) Claim(s) _____ is/are objected to.

8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9) The specification is objected to by the Examiner.

10) The drawing(s) filed on _____ is/are: a) accepted or b) objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a) All b) Some * c) None of:

1. Certified copies of the priority documents have been received.
2. Certified copies of the priority documents have been received in Application No. _____.
3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) Notice of References Cited (PTO-892)

2) Notice of Draftsperson's Patent Drawing Review (PTO-948)

3) Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date 10 December 2008 and 20 February 2009.

4) Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ .

5) Notice of Informal Patent Application

6) Other: _____.

DETAILED ACTION

Acknowledgements

1. This action is in reply to the Amendments and Remarks filed on 12 January 2009 (“09 Jan Amendments” and “09 Jan Remarks,” respectively).
2. Claims 1-26 are currently pending.
3. Claims 14-26 have been previously withdrawn.
4. Claims 1-13 have been examined.
5. This Office Action is given Paper No. 20090421. This Paper No. is for reference purposes only.

Information Disclosure Statement

6. The Information Disclosure Statements filed 10 December 2008 and 20 February 2009 have been considered. Initialed copies of the Form 1449 are enclosed herewith.

Specification

7. The specification is objected to as failing to provide proper antecedent basis for the claimed subject matter. See 37 C.F.R. §1.75(d)(1), MPEP §608.01(o), and MPEP §2181 and its discussion of C.F.R. §1.75. The specification is replete with these errors. Some examples follow. Correction of at least the following is required:

- a. The “storage means for storing said contents in advance” of claim 1;
- b. The “request means for requesting utilization of predetermined contents” of claim 1;

- c. The “reception means for receiving both a table... and a utilization condition” of claim 1;
- d. The “utilization-condition storage means for storing said utilization condition and said table” of claim 1;
- e. The “utilization execution means for executing utilization of said predetermined contents” of claim 1;
- f. The “utilization-condition transmission means for transmitting said table... and for transmitting said utilization condition” of claim 1;
- g. The “sales-history information storage means for storing sales-history information of said predetermined contents” of claim 1;
- h. The “collection means for collecting sales records of contents utilized by said terminal” of claim 1;
- i. The “processing execution means for carrying out processing based on said sales records” of claim 1;
- j. The “acquisition means for acquiring execution-history information” of claim 4;
- k. The “utilization-history information storage means for storing utilization-history information” of claim 4;
- l. The “favorite extraction means for extracting information of contents” of claim 5;
- m. The “execution-history information storage means for storing execution-history information” of claim 10; and
- n. The “execution-history information transmission means for transmitting said execution-history information” of claim 10.

Claim Rejections - 35 USC § 101

8. 35 U.S.C. §101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

9. Claims 6-13 are rejected under 35 U.S.C. §101 because the claimed invention is directed to non-statutory subject matter.

Regarding Claims 6 and 12

10. Based on Supreme Court precedent¹ and recent Federal Circuit decisions, a §101 process must (1) be tied to another statutory class (such as a particular apparatus) or (2) transform underlying subject matter (such as an article or materials) to a different state or thing. See *In re Bilski*, 88 USPQ2d 1385 (Fed. Cir. 2008) (en banc).

11. An example of a method claim that would not qualify as a statutory process would be a claim that recited purely mental steps.

12. To meet prong (1), the method step should positively recite the other statutory class (the thing or product) to which it is tied. This may be accomplished by having the claim positively recite the machine that accomplishes the method steps. Alternatively or to meet prong (2), the method step should positively recite identifying the material that is being changed to a different state or positively recite the subject matter that is being transformed.

¹ See also *Diamond v. Diehr*, 450 U.S. 175, 184 (1981); *Parker v. Flook*, 437 U.S. 584, 588 n.9 (1978); *Gottschalk v. Benson*, 409 U.S. 63, 70 (1972); *Cochrane v. Deener*, 94 U.S. 780, 787-88 (1876).

13. In this particular case, the claims fail prong (1) because the method steps are not tied to a machine and can be performed without the use of a particular machine. Additionally, the claims fail prong (2) because the method steps do not transform the underlying subject matter to a different state or thing.

Regarding Claims 7 and 13

14. As recited, claims 7 and 13 are directed toward “[a] computer readable storage medium having stored thereon a program to be executed by a computer as a program for controlling an information-processing apparatus, which is connected to a terminal for using a content through a network, to carry out processing comprising...” (emphasis added). However, under the current guidelines of 35 U.S.C. §101, “programs” or software must be tangibly embodied on a computer readable medium, and, when executed by a computer processor, perform the steps of the code. In their broadest reasonable interpretation and in light of the specification, claims 7 and 13, as recited, can be interpreted to be embodied on abstract mediums such as carrier waves and signals, and therefore not eligible for patent protection. Moreover, by reciting only “a program to be executed,” Applicants have not distinguished the claims from nonfunctional descriptive data. Accordingly, claims 7 and 13 are not eligible for patent protection.

Claim Rejections - 35 USC § 112, 2nd Paragraph

15. The following is a quotation of the second paragraph of 35 U.S.C. §112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

16. Claims 1-13 are rejected under 35 U.S.C. §112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which Applicants regard as the invention.

Regarding Claims 1-13

17. The phrase “electronic point count” is indefinite because—to one of ordinary skill in this art—the metes and bounds of the phrase cannot be reasonably determined. To support this position, the Examiner notes the following: First, the Examiner has carefully reviewed the original specification and cannot locate a lexicographic definition with the required clarity, deliberateness, and precision. Second, although the Examiner recognizes that each word within the phrase may have a particular meaning, the arrangement of these words within the context of this phrase does not reasonably apprise one of ordinary skill in this art the overall meaning of the claimed phrase. Third, the Examiner has again reviewed all documents of record in conjunction with MPEP §2141.03 including the original specification and claims. Therefore based at least upon the three points noted above and using the required precepts of English grammar, it is the Examiner’s position that the phrase “electronic point count” (as used in the context of these particular claims) is neither lexicographically defined by Applicants nor known to those of ordinary skill in this art. However, if Applicants believe that the phrase is old and well known in the art, Applicants should (in their next appropriately filed response) expressly state on the record that the phrase is old and well known in the art and provide appropriate evidence in support thereof (e.g. a U.S. patent). Upon receiving (1) Applicants’ express statement that the

phrase is old and well known in the art and (2) sufficient evidence in support thereof, the Examiner will withdraw this particular 35 U.S.C. §112, 2nd paragraph rejection.

Regarding Claims 1-5 and 8-11

18. The following claim elements are means-plus-function limitations that invoke 35 U.S.C. §112, sixth paragraph. However, the written description fails to disclose the corresponding structure, material, or acts for the claimed function:

- o. *request means for requesting utilization of predetermined contents;*
- p. *reception means for receiving a table... and a utilization condition;*
- q. *utilization-condition storage means for storing said utilization condition and said table;*
- r. *utilization execution means for executing utilization of said predetermined contents;*
- s. *utilization-condition transmission means for transmitting said table... and for transmitting said utilization condition;*
- t. *sales-history information storage means for storing sales-history information of said predetermined contents;*
- u. *collection means for collecting sales records of contents utilized by said terminal;*
- v. *processing execution means for carrying out processing based on said sales records;*
- w. *acquisition means for acquiring execution-history information;*

- x. *utilization-history information storage means for storing utilization-history information;*
- y. *favorite extraction means for extracting information of contents;*
- z. *execution-history information storage means for storing execution-history information; and*
- aa. *execution-history information transmission means for transmitting said execution-history information.*

19. Applicants are required to:

- (a) Amend the claims so that the claim limitations will no longer be means (or step) plus function limitations under 35 U.S.C. §112, sixth paragraph; or
- (b) Amend the written description of the specification such that it expressly recites what structure, material, or acts perform the claimed function without introducing any new matter (35 U.S.C. §132(a)).

20. If Applicants are of the opinion that the written description of the specification already implicitly or inherently discloses the corresponding structure, material, or acts so that one of ordinary skill in the art would recognize what structure, material, or acts perform the claimed function, Applicants are required to amend the written description of the specification such that it expressly recites the corresponding structure, material, or acts for performing the claimed function and clearly links or associates the structure, material, or acts to the claimed function, without introducing any new matter. See 35 U.S.C. §132(a).

Regarding Claims 1-7 and 9

21. These claims recite “said predetermined contents pertaining to said range.” These claims are indefinite because it is unclear to what “said predetermined contents pertaining to said range” is referencing.

Regarding Claims 8 and 13

22. These claims recite “an electronic point count for purchasing said predetermined contents to said server.” These claims are indefinite because it is unclear to one of ordinary skill in the art how an electronic point count would allow purchasing *to* a server.

23. The Examiner finds that because the claims are indefinite under 35 U.S.C. §112, 2nd paragraph, it is impossible to properly construe claim scope at this time. However, in accordance with MPEP §2173.06 and the USPTO’s policy of trying to advance prosecution by providing art rejections even though these claims are indefinite, the claims are construed and the prior art is applied as much as practically possible.

Claim Rejections - 35 USC § 103

24. The following is a quotation of 35 U.S.C. §103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

25. Claims 1-13, as understood by the Examiner, are rejected under 35 U.S.C. §103(a) as being unpatentable over Higashi et al. (U.S. 2004/0249759 A1) (“Higashi”).

Regarding Claims 1, 2, 6-8, 12, and 13

26. Higashi discloses a content-providing system comprising a terminal (“content using apparatus **103**”) for utilizing contents and a server (distribution center **101**) connected to said terminal through a network (“network **102**”) and used for managing said contents comprising: said terminal including storage means (“content storage unit **203**”) for storing said contents in advance; request means (“user interface unit” and “billing unit **211**”) for requesting utilization of predetermined contents by transmitting content IDs identifying said predetermined contents among a plurality of said contents stored in said storage means and by transmitting an electronic point count for purchasing said predetermined contents, to said server; reception means (“broadcast receiving unit **201**”) for receiving both a table associating said content IDs with said electronic point count, and a utilization condition each transmitted by said server in response to said request by said request means (“LT **404**”); utilization-condition storage means (“content use management unit **215**”) for storing said utilization condition and said table, which are received

by said reception means; and utilization execution means (“content use control unit **212**”) for executing utilization of said predetermined contents on the basis of said utilization condition and said table, which have been stored in said utilization-condition storage means; said server including utilization-condition transmission means (“right management server **101b**” and “value information distribution server **101d**”) for transmitting said table associating said content IDs with said electronic point count and for transmitting said utilization condition, to said terminal; sales-history information storage means (“right management server **101b**”) for storing sales-history information of said predetermined contents pertaining to said range as information including said content IDs identifying said predetermined contents, utilization of which is requested by said request means employed in said terminal; collection means (“right management server **101b**”) for collecting sales records of contents utilized by said terminal on the basis of said sales-history information stored in said sales-history information storage means; and processing execution means (“right management server **101b**” and “value information distribution server **101d**”) for carrying out processing based on said sales records, wherein said utilization-condition transmission means, employed in said server, is further a means for transmitting a content ID, said electronic point count of which is to be updated, and an update of said electronic point count and said utilization-condition storage means, employed in said terminal, is further a means for updating said table on the basis of said content ID and said update of said electronic point count, which are received from said server (figs. 1, 2, and 5 with associated text; ¶ 0117; ¶¶ 0159+).

27. Higashi does not use the exact phraseology “electronic point count.” Moreover, it is the Examiner’s principle position that the phraseology “electronic point count” renders the claim

indefinite. However, in light of the USPTO's policy to execute compact prosecution, the Examiner interprets the claimed "electronic point count," under the broadest reasonable interpretation standard, to be equivalent to Higashi's "value information."

Regarding Claim 3

28. Higashi further discloses wherein said sales-history information stored in said sales-history information storage means further includes an apparatus ID used for identifying said terminal (figs. 1, 2, and 5 with associated text; ¶ 0117; ¶¶ 0159+).

Regarding Claim 4

29. Higashi further discloses an acquisition means for acquiring execution-history information representing a history of executions of utilizations of said contents stored in said terminal; and utilization-history information storage means for storing utilization-history information including said content ID received from said server and said execution-history information acquired by said acquisition means, wherein said collection means further collects utilization records of contents utilized by said terminal on the basis of said utilization-history information (figs. 1, 2, and 5 with associated text; ¶ 0117; ¶¶ 0159+).

Regarding Claim 5

30. Higashi further discloses a favorite extraction means for extracting information of contents each serving as a favorite with a user using said terminal on the basis of said utilization-history information stored in said utilization-history information storage means and information

on favorites stored in said terminal, wherein said transmission means transmits information extracted by said favorite extraction means as said information of contents each serving as a favorite with said user using said terminal to said terminal (figs. 1, 2, and 5 with associated text; ¶ 0117; ¶¶ 0159+).

Regarding Claim 9

31. Higashi further discloses an ID storage means for storing an apparatus ID used for identifying said information-processing apparatus, wherein said request means transmits said apparatus ID from said ID storage means along with said content IDs of said predetermined contents pertaining to said range to be purchased and said electronic point count for purchasing said predetermined contents in order to make said request for utilization of said predetermined contents pertaining to said range (figs. 1, 2, and 5 with associated text; ¶ 0117; ¶¶ 0159+).

Regarding Claim 10

32. Higashi further discloses an execution-history information storage means for storing execution-history information representing a history of executions of utilizations of said predetermined contents; and execution-history information transmission means for transmitting said execution-history information stored in said execution-history information storage means to said server (figs. 1, 2, and 5 with associated text; ¶ 0117; ¶¶ 0159+).

Regarding Claim 11

33. Higashi further discloses said reception means further receives information on favorite contents of a user using said information-processing apparatus from said server as information based on said execution-history information; and said utilization execution means executes utilizations of said predetermined contents on the basis of said information on favorite contents (figs. 1, 2, and 5 with associated text; ¶ 0117; ¶¶ 0159+).

34. The Examiner has pointed out particular references contained in the prior art of record within the body of this action for the convenience of the Applicant. Although the specified citations are representative of the teachings in the art and are applied to the specific limitations within the individual claim, other passages and figures may apply. Applicant, in preparing the response, should consider fully the entire reference as potentially teaching all or part of the claimed invention, as well as the context of the passage as taught by the prior art or disclosed by the Examiner.

35. After careful review of the original specification, the Examiner is unable to locate any lexicographic definitions with the required clarity, deliberateness, and precision.

36. The Examiner finds that because claims 6, 7, 12, and 13 do not recite “step for,” claims 6, 7, 12, and 13 fail Prong (A) as set forth in MkPEP §2181 I. Because claims 6, 7, 12, and 13 fail Prong (A) as set forth in MPEP §2181 I., the Examiner concludes that claims 6, 7, 12, and 13 do not invoke 35 U.S.C. §112, 6th paragraph. See also *Ex parte Miyazaki*, 89 USPQ2d 1207, 1215-16 (B.P.A.I. 2008) (precedential).

Definitions

37. The Examiner hereby adopts the following definitions under the broadest reasonable interpretation standard. In accordance with *In re Morris*, 127 F.3d 1048, 1056, 44 USPQ2d 1023, 1029 (Fed. Cir. 1997), the Examiner points to these other sources to support his interpretation of the claims.² Additionally, these definitions are only a guide to claim terminology since claim terms must be interpreted in context of the surrounding claim language.

Finally, the following list is not intended to be exhaustive in any way:

- bb. *for* “1 a – used as a function word to indicate purpose.” (Webster’s Ninth New Collegiate Dictionary, Merriam-Webster, Inc., Springfield, MA, 1986); and
- cc. *associate* “3. To connect in the mind or imagination.” (The American Heritage® Dictionary of the English Language, 4th ed. Boston: Houghton Mifflin, 2000).

Response to Arguments

35 U.S.C. §101

38. Applicants’ argue “[w]ith regard to the first test, Claims 6 and 12 clearly recite that the claimed method is tied to a statutory particular machine or apparatus” (p. 19, 09 Jan Remarks). The Examiner respectfully disagrees. In response to Applicants’ argument on p. 19, the recitation “an information-processing method executed by an information-processing apparatus having a processor and connected to a terminal for using a content through a network” (as recited in claims 6 and 12) has not been given patentable weight because the recitation occurs in the

² While most definitions are cited because these terms are found in the claims, the Examiner may have provided additional definition(s) to help interpret words, phrases, or concepts found in the definitions themselves or in the prior art.

preamble. A preamble is generally not accorded any patentable weight where it merely recites the purpose of a process or the intended use of a structure, and where the body of the claim does not depend on the preamble for completeness but, instead, the process steps or structural limitations are able to stand alone. See *In re Hirao*, 535 F.2d 67, 190 USPQ 15 (CCPA 1976) and *Kropa v. Robie*, 187 F.2d 150, 152, 88 USPQ 478, 481 (CCPA 1951). By way of example only (and thereby *not* an explicit requirement), having a machine perform one of the method steps (by reciting the machine in the body of the claim) would most likely overcome this rejection.

39. Additionally, Applicants argue “[w]ith regard to Claims 7 and 13, these claims have been amended to recite computer readable storage medium claims” (p. 19, 09 Jan Remarks). This has been acknowledged by the Examiner, but this argument is not persuasive.

35 U.S.C. §112, 2nd Paragraph

40. Applicants state “[w]ith regard to item 19 on pages 7-8 pertaining to Claims 1-13, Applicants respectfully traverse the assertion that one of ordinary skill in the art would not be able to reasonably determine the metes and bounds of the phrase ‘electronic point count’” (p. 20, 09 Jan Remarks). Applicants’ traversal is acknowledged.

41. Applicants use the following excerpt from MPEP §2173.05(a), titled “New Terminology,” in support of their argument:

The requirements for clarity and precision must be balanced with the limitations of the language and the science. If the claims, read in light of the specification, reasonably apprise those skilled in the art both of the utilization and scope of the invention, and if the language is as precise as the subject matter permits, the statute (35 U.S.C. 112, second paragraph) demands no more.

42. This excerpt is drawn from a decision made in the 1985 Federal Circuit *litigation* case *Shatterproof Glass Corp. v. Libbey Owens Ford Co.* (citation available in MPEP §2173.05(a)). Because the excerpt relates to the standard for claim interpretation under 35 U.S.C. §112, 2nd Paragraph in litigation practice, the Examiner is not bound by this decision. Unlike *Shatterproof Glass*, the instant application is *ex parte examination*. To understand the standard the USPTO must meet to establish indefiniteness during ex parte examination, see *Ex parte Miyazaki*, 89 USPQ2d 1207 (B.P.A.I. 2008) (precedential).

43. In other words, the standard for claim interpretation in *ex parte examination* is *different than* the standard for claim interpretation in *litigation* because, in examination, applicants have the right to amend the claims. In *litigation*, the patentee cannot. See *In re Zletz*, 893 F.2d 319, 322, 13 USPQ2d 1320, 1322 (Fed. Cir. 1989) (manner of claim interpretation that is used by courts in *litigation* is not the manner of claim interpretation that is applicable during prosecution of a pending application before the PTO). See also *In re Morris*, 127 F.3d 1048, 1054-55, 44 USPQ2d 1023, 1027-28 (Fed. Cir. 1997) (where the Federal Circuit held that the PTO is not required, in the course of prosecution, to interpret claims in applications in the *same manner* as a district court would interpret claims in an *infringement suit*. Rather, the “PTO applies to verbiage of the proposed claims the broadest reasonable meaning of the words in their ordinary usage as they would be understood by one of ordinary skill in the art, taking into account whatever enlightenment by way of definitions or otherwise that may be afforded by the written description contained in applicant’s specification.”).

44. Additionally, Applicants argue “[i]n the present case, the specification fully and clearly describes the term ‘electronic point count’ such that one of ordinary skill in the art would

understand to what this phrase refers" (p. 20, 09 Jan Remarks). As shown below, it is the Examiner's position that simply "describing" as alleged by Applicatns is clearly *not* a lexicographic definition.

45. Applicants provide the following two citations from the written description of the instant application in support of this argument:

...the point count or the electronic point count is used in place of a fee in processing such as a process to purchase a license.

p. 53, specification; and

...in the processing represented by the flowchart shown in Fig. 34, an electronic point count for reproducing the set contents is purchased and points are consumed from the electronic point count each time a set content is reproduced.

pp. 89-90, specification.

46. The citation from page 53 suggests that the electronic point count is equivalent to a fee. The citation from pages 89-90 suggest that the electronic point count is something similar to a decremented counter that begins from a purchased value and is decremented each time content is played. Therefore, these citations describe the "electronic point count" with at least two different meanings.

47. Additionally, because these citations describe the "electronic point count" with at least two different meanings, these recitations do not lexicographically define "electronic point count" with the clarity, deliberateness, and precision required for these recitations to constitute a lexicographic definition. *See In re Paulsen*, 30 F.3d 1475, 1480, 31 USPQ2d 1671, 1674 (Fed. Cir. 1994) (inventor may define specific terms used to describe invention, but must do so "with reasonable clarity, deliberateness, and precision" and, if done, must "set out his uncommon definition in some manner within the patent disclosure' so as to give one of ordinary skill in the

art notice of the change” in meaning) (quoting *Intellicall, Inc. v. Phonometrics, Inc.*, 952 F.2d 1384, 1387-88, 21 USPQ2d 1383, 1386 (Fed. Cir. 1992)). In other words, because of the different meanings (as noted by the two citations above), one of ordinary skill in the art would *not* have sufficient notice of what constitutes the lexicographic definition of an “electronic point count.” For the record, and other than the two citations noted above, the Examiner is unable to locate any *additional* locations in the original specification where Applicants have attempted a lexicographic definition of “electronic point count” with the required clarity, deliberateness, and precision.

48. Moreover, the Examiner notes that in providing these citations, Applicants are urging the Examiner to consult the specification to interpret the claim language (namely, the “electronic point count”) more narrowly in view thereof. Claim language during examination is to be given its broadest reasonable interpretation, and it is improper for the Examiner to import limitations from the specification into the claims to narrow the claim language. This practice is USPTO policy in examination because Applicants may amend the claims to clarify any ambiguities. See the first sentence in MPEP 2111.01 and *In re Zletz*, 893 F.2d 319, 321-22, 13 USPQ2d 1320, 1322 (Fed. Cir. 1989) (“During patent examination the pending claims must be interpreted as broadly as their terms reasonably allow.... The reason is simply that during patent prosecution when claims can be amended, ambiguities should be recognized, scope and breadth of language explored, and clarification imposed.... An essential purpose of patent examination is to fashion claims that are precise, clear, correct, and unambiguous. Only in this way can uncertainties of claim scope be removed, as much as possible, during the administrative process.”). See also *In re Morris*, 127 F.3d 1048, 44 USPQ2d 1023 (Fed. Cir. 1997).

49. In light of the above and the notice function of the claims, the Examiner respectfully recommends (by way of example only) that Applicants recite in the claim(s) any of their desired definition(s). Like always, Applicants are cautioned that no new matter is allowed.

50. In conclusion, because “electronic point count” is not lexicographically defined (see above), because “electronic point count” does not invoke 35 U.S.C. § 112 6th paragraph, and because Applicants have failed to provide any evidence to show that “electronic point count” is old and well-known in the art (as requested in the previous Office action, Paper No. 20080924, ¶ 19 o.), the phrase “electronic point count” is indefinite because in the context of the particular claims, the metes and bounds of the phrase cannot be reasonably determined.

35 U.S.C. §112, 2nd Paragraph with respect to 35 U.S.C. §112, 6th Paragraph

51. Applicants state “[w]ith regard to item 20 on pages 8-9 pertaining to Claims 1-5 and 8-11, Applicants respectfully traverse that the written description fails to disclosure the corresponding structure, material or acts for the claimed invention” (p. 20, 09 Jan Remarks). Traversal is acknowledged.

52. Additionally, Applicants argue “the outstanding Action should not have been searching the specification for the exact terms such as “storage means” or “request means” but instead should have been searching the specification to determine what structure (or material or acts) will perform the recited function” (p. 21, 09 Jan Remarks). The Examiner has never stated that his search was limited to “exact terms.” In the previous Office action, the Examiner stated “the Examiner has searched the original specification for the terms of the above limitations (e.g.

storage means, request means, etc.)....." Here the Examiner was giving exemplary search terms, hence the use of "e.g."

53. Additionally, Applicants provide the following excerpt from MPEP §2181 in support of their argument:

The proper test for meeting the definiteness requirement is that the corresponding structure (or material or acts) of a means (or step)-plus-function limitation must be disclosed in the specification itself in a way that one skilled in the art will understand what structure (or material or acts) will perform the recited function. See Atmel Corp. v. Information Storage Devices, Inc., 198 F.3d 1374, 1381, 53 USPQ2d 1225, 1230 (Fed. Cir. 1999)...The disclosure of the structure (or material or acts) may be implicit or inherent in the specification if it would have been clear to those skilled in the art what structure (or material or acts) corresponds to the means (or step)-plus-function claim limitation. See Id. at 1380, 53 USPQ2d at 1229; In re Dossel, 115 F.3d 942, 946-47, 42 USPQ2d 1881, 1885 (Fed. Cir. 1997).

54. The Examiner agrees with the statements of law above. However corresponding structure (or material or acts) of the means are *not* disclosed. In essence, Applicants appear to be arguing that the corresponding structure is within the specification somewhere. This is not persuasive because Applicants have not pointed out the *particular* structure.

55. Additionally, Applicants request that "any future Office Action properly examine the disclosure to determine what structure (or material or acts) will perform the recited function" (p. 22, 09 Jan Remarks). As noted by the Federal Circuit, "[s]uch an approach puts the burden in the wrong place. It is the [A]pplicants' burden to precisely define the invention, not the PTO's." *In re Morris*, 44 USPQ2d at 1029. Nevertheless and like always, the Examiner *has* examined the disclosure. However upon examining the original disclosure, the Examiner was unable to determine what structure (or material or acts) perform the recited functions.

56. Additionally, Applicants provide the following excerpt from MPEP §2182 in support of their argument:

...an examiner carries the initial burden of proof for showing that the prior art structure or step is the same as or equivalent to the structure, material, or acts described in the specification which has been identified as corresponding to the claimed means or step plus function.

57. First, the Examiner agrees with this general statement of law. However, this excerpt has nothing to do with correlating “means for” language in the claims with the corresponding structure in the specification. See *In re Morris* (Id.). This excerpt relates to prior art rejections. Moreover, Applicants request that “the Office follow the mandates of MPEP §2182 by appropriately defining and correlating the structure and identical function of the means-plus-function elements (in view of the specification) in any future communication” (p. 22, 09 Jan Remarks).

58. Again, the Examiner has complied with the MPEP. But gain, it is Applicants’ burden to clearly link and associate the corresponding structure to the claimed function--not the Examiner’s. Because it is Applicants’ burden, *there is no such mandate in MPEP §2182*. In fact, there is no mandate anywhere in the MPEP that mandates the USPTO to define Applicants’ invention. The Examiner highly recommends Applicants review *In re Morris*.

Prior Art

59. Applicants’ arguments with respect to claims 1-13 have been considered but are moot in view of the new ground of rejection.

Conclusion

60. Applicants' 09 Jan Amendment necessitated the new grounds of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a).

Applicants are reminded of the extension of time policy as set forth in 37 C.F.R. §1.136(a).

61. A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 C.F.R. §1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

62. Because this application is now final, Applicants are reminded of the USPTO's after final practice as discussed in MPEP §714.12 and §714.13 and that entry of amendments after final is *not* a matter of right. "The refusal of an examiner to enter an amendment after final rejection of claims is a matter of discretion." *In re Berger*, 279 F.3d 975, 984, 61 USPQ2d 1523, 1529 (Fed. Cir. 2002) (citations omitted). Furthermore, suggestions or examples of claim language provided by the Examiner are just that—suggestions or examples—and do not constitute a formal requirement mandated by the Examiner. Unless stated otherwise by an express indication that a claim is "allowed," exemplary claim language provided by the Examiner to overcome a particular rejection or to change claim interpretation has *not been addressed* with respect to other aspects of patentability (*e.g.* §101 patentable subject matter, §112, 1st paragraph written

description and enablement, §112, 2nd paragraph indefiniteness, and §102 and §103, prior art).

Therefore, any claim amendment submitted under 37 C.F.R. §1.116 that incorporates an Examiner suggestion or example or simply changes claim interpretation will nevertheless require further consideration and/or search and a patentability determination as noted above.

63. Applicants are reminded that during ex parte examination, anticipation requires the examiner to meet the ‘All Elements Test.’ “It is axiomatic that anticipation of a claim under §102 can be found only if the prior art reference discloses every element of the claim, and that anticipation is a fact question . . .” *In re King*, 231 USPQ 136, 138 (Fed. Cir. 1986); see also *In re Schreiber*, 128 F.3d 1473, 1477, 44 USPQ2d 1429, 1431 (Fed. Cir. 1997) (“To anticipate a claim, a prior art reference must disclose every limitation of the claimed invention, either explicitly or inherently.”). In other words, all elements of the claimed invention must be disclosed in some fashion for the claim to be anticipated. Additionally, the All Elements Test is equally applicable to method claims although it is each method step which must be shown. “A method or process consists of one or more operative steps, and, accordingly, it is well established that a patent for a method or process is not infringed unless all steps or stages of the claimed process are utilized.” *NTP Inc. v. Research In Motion Ltd.*, 75 USPQ2d 1763, 1790 (Fed. Cir. 2005)(citations and quotations omitted). Logically, the lack of a single structural element or step would negate anticipation. “[A]bsence from the reference of any claimed element negates anticipation.” *Kloster Speedsteel AB v. Crucible, Inc.*, 793 F.2d 1565, 1571, 230 USPQ 81, 84 (Fed. Cir. 1986).

64. Yet it is important to keep in mind that “[a]n anticipatory reference, however, need not duplicate word for word what is in the claims.” *Standard Havens Prods., Inc. v. Gencor Indus.*,

Inc., 953 F.2d 1360, 1369, 21 USPQ2d 1321, 1328 (Fed. Cir. 1991). “While a reference must be considered not only for what it expressly teaches, but also for what it fairly suggests” *In re Bell*, 991 F.2d 781, 785, 26 USPQ2d 1529, 1532 (Fed. Cir. 1993) (citations and quotations omitted).³ In other words, “[t]he use of patents as references is not limited to what the patentees describe as their own inventions or to the problems with which they are concerned. They are part of the literature of the art, relevant for all they contain.” *In re Heck*, 699 F.2d 1331, 1332-33, 216 USPQ 1038, 1039 (Fed. Cir. 1983)(quoting *In re Lemelson*, 397 F.2d 1006, 1009, 158 USPQ 275, 277 (CCPA 1968)).⁴

65. The Examiner hereby gives notice that for anticipation, the Examiner can combine that what is old and well known in the art in combination with a reference. “A reference anticipates a claim if it discloses the claimed invention ‘such that a skilled artisan could take its teachings in combination with his own knowledge of the particular art and be in possession of the invention. [Emphasis in original.]’” *In re Graves*, 69 F.3d 1147, 1152, 36 USPQ2d 1697, 1701 (Fed. Cir. 1995) citing *In re LeGrice*, 301 F.2d 929, 936, 133 USPQ 365, 372 (CCPA 1962) and noting that regarding the claimed “simultaneously monitoring the selected multiple connection points,” the prior art “nevertheless anticipates [the claimed invention], even if it does not specifically disclose simultaneous monitoring of the output points, if simultaneous or parallel monitoring is within the knowledge of a skilled artisan.” *Graves*, 69 F.3d at 1152, 36 USPQ2d at 1701. See also *Helifix Ltd. v. Blok-Lok, Ltd.*, 208 F.3d 1339, 1347, 54 USPQ2d 1299, 1304 (Fed. Cir. 2000)

³ See also *In re Widmer*, 353 F.2d 752, 757, 147 USPQ 518, 523 (CCPA 1965)(noting that a reference is not limited to its examples, but is available for all that it fairly discloses and suggests).

⁴ See MPEP §2123, Subsection titled “Patents Are Relevant as Prior Art for All They Contain.”

(noting that “The brochure might nevertheless be anticipating if a person of ordinary skill in the art would understand the brochure as disclosing elements (8)-(10) and if such a person could have combined the brochure’s description of the invention with his own knowledge to make the claimed invention.”); and *In re Donohue*, 766 F.2d 531, 533, 226 USPQ 619, 621 (Fed. Cir. 1985) (“Such possession is effected if one of ordinary skill in the art could have combined the publication’s description of the invention with his own knowledge to make the claimed invention,” citing *In re LeGrice*, 301 F.2d at 939, 133 USPQ at 373-74.).

66. Any inquiry of a general nature or relating to the status of this application or concerning this communication or earlier communications from the Examiner should be directed to Jacob C. Coppola whose telephone number is (571) 270-3922. The Examiner can normally be reached on Monday-Friday, 9:00 a.m. - 5:00 p.m. If attempts to reach the Examiner by telephone are unsuccessful, the Examiner’s supervisor, Andrew Fischer can be reached at (571) 272-6779.

67. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, please contact the Electronic Business Center (EBC) at (866) 217-9197 (toll-free).

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